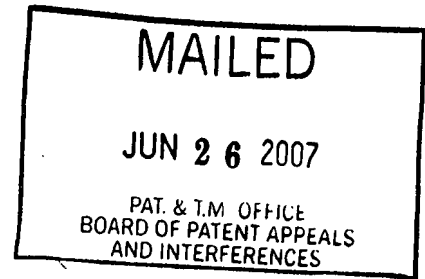


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte LARRY S. YAEGER, RICHARD W. FABRICK II,
and GIULIA M. PAGALLO

Application 09/520,206



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on June 1, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

February 23, 2006, Appellants filed an Appeal Brief. A review of the file reveals that the "Summary of Claimed Subject Matter" does not map each the

independent claim to the specification, as set forth in 37 CFR § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

A review of the Brief reveals that independent claim 42 was not including under the heading “Summary of claimed subject matter”.

Proper correction of the Appeal Brief is required.

When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

EXAMINER ANSWER

The Examiner's Answer mailed June 14, 2006, does not fully comply with the requirements of 37 CFR § 41.37. An in-depth review of the answer reveals that the following headings need to be included in accordance with MPEP § 1207.02:

- 1) Summary of the claimed subject matter;
- 2) Grounds of rejection to be reviewed on appeal;
- 3) Claims Appendix;
- 4) Response to Argument
- 5) Related Proceedings Appendix.

A revised Examiner's Answer that is in full compliance with Manual of Patent Examining Procedure (MPEP) § 1207.02 is required.

ACKNOWLEDGMENT OF REPLY BRIEF

On September 29, 2006, the examiner mailed a communication acknowledging receipt of Appellants' Reply Brief, dated August 16, 2006. A review of the Response to Reply Brief reveals that the examiner did not provide proper acknowledgment. The comments made by the examiner would constitute being a Supplemental Examiner's Answer.

The Examiner's response to Reply Brief as set forth in MPEP § 1208, which states:

(a)(1)After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2)A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

A review of the Response to Reply Brief reveals that the examiner did not provide proper approval.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on February 23, 2006, defective;
- 2) notify appellants to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);

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- 3) vacate the Examiner's Answer mailed June 14, 2006, and issue an Examiner Answer that is in compliance with MPEP § 1207.02 ;
- 4) vacate the examiner Acknowledgment to the Reply Brief mailed September 29, 2006;
- 5) proper acknowledgment of the Reply Brief is required and/or appropriate consideration of the Reply Brief dated August 16, 2006;
- 6) acquiring approval for any Supplemental Examiner's Answer in response to the Reply Brief mailed August 16, 2006, if appropriate; and
- 7) for such further action as may be deemed appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



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PJN/pgc

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